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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/317,303    05/24/99    DONOHO    B    DONO-7

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PM82/1103

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EXAMINER

PALO, F

ART UNIT	PAPER NUMBER
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3644

11

DATE MAILED: 11/03/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/317,303

Applicant(s)

DONOHU, BRUCE A.

Examiner

Francis T. Palo

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-6, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-6, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

PETER M. POON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

*pmp*  
*11/2/00*

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2000 is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 13 March 2000 is: a) ☐ approved b) ☒ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
  2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
  3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Unitary Configured Bird Repellent Apparatus [Attorney Docket DONO-7]:

The Continued Prosecution Application Request filed 10/17/00 is acknowledged; the absence of a preliminary amendment with the Continued Prosecution Application filing is likewise acknowledged.

As such, the Amendment filed 3/21/00 is pending in this Continued Prosecution Application; with original claims 1,2 and 7 cancelled, and claims 3 through 6 and 8 pending with newly presented independent claim-9 added.

### ***Drawings***

1. The corrected or substitute drawings were received on 3/13/00. These drawings are not acceptable and have not been entered of record.
2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 3/13/00 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of the notch (19) in the rail (15).

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3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the notch (19) must be shown at "various locations along the base member (12)" [not along the rail (15)] or the feature(s) canceled from the claim(s). No new matter should be entered.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: (17). Correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 5, 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw (US 3,282,000) 1966.

Regarding new claim-9:

Shaw '000 discloses a bird repellent apparatus comprising:

- An elongated base member (4) for attachment to an underlying surface;  
[column-3, lines 45-46]
- A plurality of elongated prongs (20) extending from the base member at selected spaced intervals along the length of the base member; [column-2, lines 51-59]

Shaw does not disclose the base member (4) and prongs (20) being made of a unitary injection-molded plastic structure.

Shaw does disclose the base member is adapted to be attached to diverse different types of surfaces if formed from plastic [column-3, lines 56-62] and the lateral projections or spikes can be integrally molded [column-5, lines 56-58] and that one should appreciate the apparatus readily adapts itself to molding techniques such as are commonly used in the formation of plastic elements.

[column-5, lines 73-75 and column-6, lines 1-4]

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have made the apparatus of Shaw a unitary injection-molded plastic structure; since the apparatus readily adapts itself to molding techniques such as are commonly used in the formation of plastic elements [injection-molding is commonly used in the formation of plastic elements] furthermore, it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

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Shaw as modified, does not disclose the injection-molded plastic of the base member as having at least one cutting groove to facilitate separating the base member at the groove for dividing a unitary length of the apparatus into separate shorter lengths.

Shaw does disclose that the base member can be manufactured in lengths and then cut to a particular size so as to fit on a given ledge, sill or the like [column-3, lines 56-59].

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have provided the apparatus of Shaw as modified, with at least one cutting groove; as further such modification is merely an alternate equivalent means to facilitate separating the base member or for dividing a unitary length of the apparatus into separate shorter lengths.

Regarding claim-3:

The discussion and features regarding claim-9 as discussed above are relied upon.

The apparatus of Shaw as modified, further comprises means for securing the base member to the underlying surface. [Figures 2 and 3; column-3, lines 45-55]

Regarding claims 5 and 6:

The discussion and features regarding claim-9 as discussed above are relied upon.

The apparatus of Shaw as modified, is provided with elongated prongs extending from the base member at predetermined angles along the length of the base member [column-4, lines 1-4; and Figures 1,4 and 7-11]. The predetermined angles as cited in the instant claim-6 are evident from the aforementioned Figures.

7. Claim-4 is rejected under 35 U.S.C. 103(a)  
as being unpatentable over Shaw '000 in view of Donoho (US 5,253,444) 1993.

Regarding claim-4:

The discussion and features regarding claim-9 as discussed above are relied upon.

Shaw discloses and depicts a variety of sharply pointed prongs.

Shaw does not specifically disclose an elongated circular cylindrical shaft.

Donoho '444 depicts a conical prong configuration terminating in a tapered sharpened tip in Figure-3 and further teaches that the exact shape of each prong is a matter of choice [column-3, lines 29-32].

In the absence of any stated problem solved by or any advantage obtained by having an elongated circular cylindrical shaft prong; it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have provided the apparatus of Shaw as modified, with an elongated circular cylindrical shaft prong as a matter of design choice as taught by Donoho '444.

8. Claim-8 is rejected under 35 U.S.C. 103(a)  
as being unpatentable over Shaw '000 in view of Negre (US 5,400,552) 1995.

Regarding claim-8:

The discussion and features regarding claim-9 as discussed above are relied upon.

Shaw does not specifically disclose the use of glue in the base member trough depicted in Figure-4 or at the chamfers in the base depicted in Figure-1.

Negre '552 teaches a bird repellent apparatus filled with glue (7) which flows out onto the base support to effectively secure the base support to a surface to be protected from birds [column-4, lines 1-3].

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have provided the trough depicted in Figure-4 of Shaw as modified, with glue for attaching the base member to an underlying surface as taught by Negre; as further such modification is merely a well known alternate fastening means performing the same intended function of attaching a base member to an underlying surface.



***Conclusion***

9. This is a Continued Prosecution Application of applicant's earlier Application No. 09/317,303. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed,

and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 703-305-5595. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M Poon can be reached on 703-308-2574. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4180.

*Francis T. Palo*

Francis T. Palo  
November 2, 2000

*Peter M. Poon*

PETER M. POON  
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11/2/00